

Appl. No. 09/752,372

Amended Dated November 1, 2004

Reply to Office Action of June 30, 2004 (Paper No. 11)

Remarks

Claims 3-8, 10-14, 17-19, 22-24, 27-29, and 31-39 remain standing in this application. Claims 3, 10, 13, 17, 18, 19 and 22-24 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims is respectfully requested.

Claims 3-8, 10, 11, 13, 14, 17-19 and 22-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by IETF RFC 791. Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the rejection.

As presented in previous communications, Applicant submits that the Type of Service parameter and Control Flag parameter as described in IETF RFC 791 are independent of each other. RFC 791 does not discuss any relationship between the Control Flag parameter and Type of Service parameter. Rather, the Type of Service parameter and Control Flag parameters are independent parameters that may be set without regard to each other.

According to the Office Action, Applicant's previous arguments were found unpersuasive since "the features upon which applicant relies (i.e., the two parameters are independent) are not recited in the rejected claim(s)." Office Action, Page 5.

Independent claims 3, 10, 13, 17, 18, 19 and 22-24 have been amended to further clarify this distinction. Accordingly, Applicant respectfully requests removal of the rejection.

Claims 27-29 and 31-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,541,919 (Young). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

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The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 27-29 and 31-37. Therefore claims 27-29 and 31-37 define over the Young reference. For example, claims 27-29 and 31-37 recite the following language, in relevant part:

determining an operating parameter for a packet;
determining a packet fragment size using said operating parameter; and
performing packet fragmentation for said packet using said packet
fragment size, wherein said operating parameter comprises a
connection speed.

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As indicated in the Office Action, Young fails to describe packet fragmentation. Office Action, Page 3. Consequently, Young et al. fails to disclose all the recited elements of claims 27-29 and 31-37.

Furthermore, Applicant submits that the Office Action fails to provide a proper motivation to modify the teachings of the Young reference in an attempt to arrive at the claimed subject matter. See MPEP § 2143.01, for example. The motivation to make the alleged combination must be found either in the cited references or in the knowledge generally available to a person of ordinary skill in the art. *Supra*. Possible sources for a motivation to combine references may include the knowledge of persons of ordinary skill in the art. The Office, however, cannot rely solely upon the level of skill in the art to provide the suggestion to make the alleged combination of cited references. *Supra*. Initially, the burden is on the Office to provide some suggestion that it is desirable to do what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." See MPEP § 2142, for example. According to the Office Action, "it would have been obvious to one having ordinary skill in the art to incorporate fragmentation of a packet into Young when the bit stream has the packet format and the packet size is long enough to cause transmission delay." Office Action, Page 4. Applicant respectfully disagrees. As previously submitted, Young fails to discuss packet fragmentation in any context. Therefore, it follows a fortiori that Young does not provide the requisite motivation. In addition, Young attempts to vary the

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size of an entire packet based on the fullness of a buffer and available bit-rate of an output channel. Varying a packet length as described in Young, however, is different from "performing packet fragmentation" as recited in claims 27-29 and 31-37. For example, packet fragmentation may need to use fragmentation headers, which may introduce additional delay in the system. See Specification, Page 9, Lines 11-13. Therefore, a person of ordinary skill in the art would have no motivation to translate the packet length varying techniques described in Young absent a specific teaching by Young or some other reference.

For at least the reasons given above, claims 27-29 are non-obvious and represent patentable subject matter over the Young reference. Accordingly, removal of the rejection for claims 27-29 and 31-37 is respectfully requested.

We would like to thank the Examiner for indicating the allowability of claims 12, 38 and 39 if amended to include all of the limitations of the base claims and any intervening claims. Claim 12 depends from independent claim 10. Claims 38 and 29 depend from independent claim 27. Therefore, it is respectfully submitted that these claims represent patentable subject matter in their current form for at least the same reasons given for claims 10 and 27 above.

Applicant submits that claims 3-8, 10-14, 17-19, 22-24, 27-29 and 31-39 are in allowable form. Accordingly, a Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

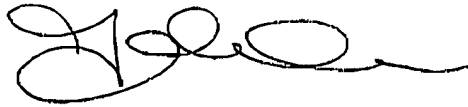
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The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



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Under 37 CFR 1.34(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: 11-1-04.


Deborah L. Higham

11-1-04
Date

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